

Notice of Allowability

Application No.

09/347,311

Examiner

Joseph T. Woitach

Applicant(s)

PLAETINCK ET AL.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to March 25, 2005.
2. ☒ The allowed claim(s) is/are ²¹1-15, 17-~~22~~, 38-45, 47 and 92-99.
3. ☒ The drawings filed on 21 July 1999 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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DETAILED ACTION

This application, filed July 2, 1999, claims benefit of foreign applications: GB 9814536.0, filed July 3, 1998, and GB 9827152.1, filed December 9, 1998, both filed in Great Britain.

Applicant's after final amendment filed March 25, 2005, has been received and entered. Claims 1, 3-8, 17, 18, 20 and 21 have been amended. Claims 93-99 have been added. Claims 16, 22-37, 46, 48-91 have been canceled. Claims 1-15, 17-22, 38-45, 47 and 92-99 are pending.

Election/Restriction

Claims 1-15, 17-22, 38-45, 47 and 92-99 are pending. Election was made without traverse in Paper No. 17.

Non-elected claim 22 has been cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15, 17-21, 23, 24, 38-45, 47, 48 and 92 rejected under 35 U.S.C. 102(e) as being anticipated by Fire *et al.* (US Patent 6,506,559 B1) is withdrawn.

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The filing date of the '559 patent is December 18, 1998, and it claims priority to a provisional application filed December 23, 1997. While some of the embodiments taught in *Fire et al.* patent has an earlier effective filing date than the instant application and qualifies as a 102(e) type reference, the claims as amended would not be anticipated nor obvious over the teachings that are supported by the 60/068,562 provisional disclosure.

In view of the amendments to the claims, and upon review of the teachings in the provisional application of *Fire et al.* (60/068,562, filed December 23, 1997), Applicant's arguments have been fully considered, and found persuasive.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15, 17-21, 23, 24, 38-45, 47, 48 and 92 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of copending Application No. 10/057,108 is withdrawn.

As indicated previously, the conflicting claims are not identical, but they are not patentably distinct from each other because the claimed methods are both drawn to administering

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dsRNA to *C. elegans* through the use of a micro-organism. Each require the use of vectors that express a DNA and result in a dsRNA. Each encompass the use of a DNA library and for providing the micro-organism comprising the vector to *C. elegans* in order to determine the phenotypic affect of silencing the expression of a gene. However, since this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented, and this is the earlier filed application, the provisional rejection is withdrawn.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

As discussed above, while the non-provisional application of Fire *et al.* provide teachings that anticipate the claimed invention provisional application fails to teach or make obvious the instantly claimed invention. Specifically, Fire fails to teach to make and administer a complete library of genes for screening, or to teach to administer the dsRNA by feeding of a micro-organism. As noted in the Interview summary, it was agreed that claims encompassing these limitations would not be anticipated by Fire *et al.* because the provisional application did not support these embodiments therefore it was not entitled to the priority date afforded by the provisional application filing date.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Voitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Voitach

JOSEPH WOITACH, PH.D.
PRIMARY EXAMINER

Joe Voitach
AV1632